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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,620	08/19/2003	Markus Donges	600.1278	4962
23280	7590	12/01/2004	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			MORRISON, THOMAS A	
		ART UNIT		PAPER NUMBER
				3653

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/643,620	DONGES ET AL. <i>(Signature)</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Thomas A. Morrison	3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 August 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 and 12-16 is/are rejected.
- 7) Claim(s) 11 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 August 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>08/19/2003</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. In particular, the figures of the instant application do not show any shutter-like roller as set forth in claim 14. Therefore, a shutter-like roller must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, MPEP, section 2173.05(p) states, "A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph." Id. Claim 1 and its dependent claims 2-8 recite the **machine** including a delivery device and a drive for conveying the substrate sheets... the **method** comprising closing the opening or maintaining the opening in a closed position when no substrate sheet is conveyed through the opening. Since claim 1 and its dependent claims 2-8 claim both an apparatus and the method steps of using the apparatus, these claims are indefinite.

Regarding claim 14, it is unclear what is meant by the term "shutter-like".

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, claims 1-8 are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as

to set forth the statutory classes of invention in the alternative only. See, MPEP, section 2173.05(p). In particular, claims 1-8 recite both a process and a machine.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 5-6, 8-10 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Dilling et al. As best understood, Dilling et al. discloses all of the limitations set forth in claims 1-2, 5-6, 8-10 and 12-16.

Regarding claim 1, Dilling et al. discloses a method for operating a machine (1) that processes printing substrates in sheet form, the machine (1) including a delivery device (3) and a drive (51, 52) for conveying the substrate sheets, the delivery device (3) having at least one opening (at 22),

the substrate sheets being conveyed from an inside (Fig. 3) of the delivery device (3) to an externally accessible region (25), the machine including a control device (55) controlling at least one closing device (column 2, line 67 to column 3, line 4) for opening or closing the opening (at 22),

the control device (55) being operatively connected to the drive (51, 52) of the delivery device (3), the method including

closing the opening (at 22) or maintaining the opening (at 22) in a closed position when no substrate sheet is conveyed through the opening (at 22). It is noted that it appears that no substrate sheet is ever conveyed through the opening (at 22), which

satisfies the claimed limitation. See column 2, lines 4-12 and lines 50-55 for an explanation of the operation of the Dilling et al. apparatus.

Regarding claim 2, column 2, lines 4-9 and 50-55, and column 2, line 67 to column 3, line 4 disclose that the opening (at 22) is closed or opened using an operating control element; and the opening (at 22) is capable of being opened only when the drive (51,52) is at rest; the drive (51,52) being capable of operation only when the opening (at 22) is closed.

Regarding claim 5, column 2, lines 50-55 and column 2, line 67 to column 3, line 4 disclose that after the drive (51, 52) of the machine (1) has come to a stop, the opening (at 22) is in an open position or is opened by the control device (55).

Regarding claim 6 of the instant application, Dilling et al. discloses that the opening (at 22) is in the closed position or is closed by the control device (55) before the drive (51, 52) is put into operation and when no substrate sheets protrude through the opening (at 22) to the outside. It is noted that it appears that no substrate sheets ever protrude through the opening (at 22) to the outside, which satisfies the claimed limitation.

Regarding claims 8 and 15, the machine (1) is a printing press. See column 3, lines 42-45.

Regarding claims 9 and 16, Dilling et al. discloses a device for a machine (1) that processes printing substrates in sheet form including a delivery device (3) including a drive (51,52) for conveying substrate sheets and having at least one opening (at 22),

the substrate sheets capable of being conveyed from an inside (Fig. 2) of the delivery device (3) to an externally accessible region (25),

the delivery device (3) including at least one closing device (column 2, line 67 to column 3, line 4) for opening or closing the opening (at 22);

a control device (55) for controlling the closing device and being operatively connected to the drive (51, 52), the control device (55) closing the opening (at 22) or maintaining the opening (at 22) in a closed position when no substrate sheet is conveyed through the opening (at 22). Again, it appears that no substrate sheets are ever conveyed through the opening, which satisfies the claimed limitation. With regard to the printing press limitation in claim 16, the machine (1) is a printing press.

Regarding claim 10, Dilling et al. discloses sensors or contacts (30, 31) at the closing device to detect a state of the closing device.

Regarding claim 12, the closing device includes at least one movable closing element (22) controllable by the control device (55).

Regarding claim 13, the closing device includes three movable closing elements (22, 22, 22) controllable by the control device (55).

Regarding claim 14, as best understood, Dilling et al. discloses that the movable closing element (22) is a shutter-like roller. See column 4, lines 54-58 and Fig. 2.

#### ***Allowable Subject Matter***

5. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The fact that the examiner has not made

prior art rejections of claims 3, 4 and 7 should not be construed to mean that claims 3, 4 or 7 contain allowable subject matter.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

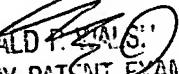
U.S. Patent Nos. 3,846,816 (Gaisser) discloses a printing machine with a delivery device, a controller, a drive and contacts; and

U.S. Patent No. 6,427,586 (Takahashi) discloses a printing machine with a delivery device, a controller, a drive and sensors.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is 703-305-0554. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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